The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDRE M. GOINEAU and JERRY N. KING



Appeal No. 2000-0922
Application 08/863,113

ON BRIEF

Before CALVERT, FRANKFORT, and McQUADE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 11 to 18, all the claims remaining in the application.

The claims on appeal are drawn to a process of fully orienting a yarn, and are reproduced in the appendix of appellants' brief, except for the addition to claim 11 noted by the examiner.

The references applied in the final rejection are:

| | | |
|---|---|---|
| Gorrafa | 4,043,010 | Aug. 23, 1977 |
| Goineau | 5,172,459 | Dec. 22, 1992 |

The appealed claims stand finally rejected on the following grounds:[1]

(1) Claims 11 to 18, unpatentable for failure to comply with the written description requirement of 35 U.S.C. § 112, first paragraph;

(2) Claims 11 and 15, unpatentable over Goineau, under 35 U.S.C. § 103(a);

(3) Claims 12 to 14 and 16 to 18, unpatentable over Goineau in view of Gorrafa, under 35 U.S.C. § 103(a).

Rejection (1)

Claim 11 reads (emphasis added):

A process to provide a fully oriented single ply industrial yarn from a single ply low molecular weight polyester partially oriented yarn comprising the steps of: providing a bobbin of single ply polyester POY multifilament yarn, supplying the single ply yarn to a heater, drawing said single ply in a draw zone in the range of 1.8-2.3 as it passes over the heater to produce a fully oriented, single ply yarn and supplying the fully oriented single ply yarn directly to a take-up roll without further processing.

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[1] A further rejection of claims 11 to 18 under 35 U.S.C. § 112, second paragraph, has been overcome in view of the entry of the amendment filed on January 11, 1999.

The examiner takes the position that the application as filed lacks a written description, as required by the first paragraph of 35 U.S.C. § 112, of the expressions "single ply" and "without further processing" (final rejection (Paper No. 8), page 2). We will consider each of these expressions in turn.

"Single Ply"

It is not disputed that the expression "single ply" does not appear in the application as filed. However, as stated in In re Smith, 481 F.2d 910, 914, 178 USPQ 620, 624 (CCPA 1973):

> Claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement. . . . The specification as originally filed must convey clearly to those skilled in the art the information that the applicant has invented the specific subject matter later claimed.

See also In re Mott, 539 F.2d 1291, 1297, 190 USPQ 536, 541 (CCPA 1976) ("application must contain sufficient disclosure, expressly or inherently, to make it clear to persons skilled in the art that appellant possessed the subject matter claimed"), and Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). In making a rejection on the ground of lack of written description, the examiner bears the initial burden of presenting a prima facie case of unpatentability; the burden then shifts to the applicant to show that the invention as

claimed is adequately described to one skilled in the art, and after the applicant has submitted evidence or argument in response, "patentability is determined on the totality of the record, by a preponderance of the evidence with due consideration to persuasiveness of argument." In re Alton, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583-84 (Fed. Cir. 1996).

We consider that the examiner has made out a prima facie case of lack of written description with regard to the claim expression "single ply." In the specification as filed, appellants do not describe the yarn used in the claimed method as being single ply, but rather disclose at page 1, lines 18 to 21, that:

> As discussed briefly, the invention is directed to low molecular weight POY multifilament, synthetic polymeric yarn such as polyester, nylon, etc. but in the preferred embodiment of the invention, a low molecular weight polyester 255 denier, 34 filament yarn 10 is shown being supplied from bobbins 12 through a reed 14 to the rolls 16, 18.

As the examiner states on page 4 of the answer,[2] "the specification is unclear as to whether the 255 denier, 34 filament yarn is single ply, double ply or triple ply."

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[2] References herein to the examiner's answer are to the Supplemental Examiner's Answer mailed Apr. 10, 2001 (Paper No. 15).

Appellants submitted only an argument, rather than any evidence, in response to the rejection. The totality of their argument is stated on page 3 of their brief as:

> The rejection under 35 U.S.C. 112, 1st paragraph is clearly erroneous. The term "single ply" is clearly supported by the recitation on Page 1, line 20 of "a low weight" polyester 255 denier, 34 filament yarn. In textile terminology, if this yarn was two ply, three ply, etc., the yarn would be described as such which obviously it isn't. Therefore, this description describes a single ply yarn.

This argument is not persuasive. Appellants cite no basis for their assertion to the effect that in "textile terminology" a lack of mention of the ply of the yarn is indicative that it is single ply. This assertion is simply argument, which cannot take the place of evidence, In re Wiseman, 596 F.2d 1019, 1022, 201 USPQ 658, 661 (CCPA 1979), and is insufficient to rebut the examiner's prima facie case.

Moreover, we note that the dictionary[3] defines the term "yarn" as (emphasis added):

> a continuous strand often of two or more plies that is composed of carded or combed fibers twisted together by spinning, filaments laid parallel or twisted together, or a single filament, is made from natural or synthetic fibers and filaments or blends of these, and is used for the warp and weft in weaving and for knitting or other interlacings that form cloth.

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[3] Webster's Third New International Dictionary (1971).

Absent any other evidence, this would tend to indicate, contrary to appellants' argument, that one of ordinary skill would not necessarily regard a disclosure of "yarn", per se, as describing a single ply yarn.

"Without Further Processing"

In appellants' disclosed process, the yarn, after passing the draw zone 23 (Fig. 1), or draw zones 21 and 23 (Fig. 2), passes through a dancer roll arrangement 34 to the take-up roll 36. The examiner asserts that the claim expression "without further processing," not being expressly disclosed in the application as filed, lacks written description because (answer, pages 4 and 5):

> as clearly seen in the figures 1 and 2 the yarn is fed through a dancer roll and is tensioned. This is self evidently further processing of the yarn since tension is placed on the yarn. Applicant's preclusion of any further processing by the statement "without further processing" is new matter since no where within the original specification is it stated that further processing should not take place.

Here again, appellants have not submitted any evidence in rebuttal, but only argue that (brief, page 3):

> Relative the term "without further processing", Figures 1 and 2 clearly support the use of this term since the yarn from the rolls 28 and 30 is clearly directed to the take-up roll 36 without further processing since the dancer roll arrangement 34 merely maintains tension in the yarn, but does not process the yarn as indicated by the Examiner.

We do not agree with this argument. "Without further processing" is contrary to appellants' disclosed process, because placing tension on the yarn via dancer roll 34 would constitute "processing," as broadly recited, just as tensioning the yarn via the other rolls 20, 22, etc. constitutes "processing."

In any event, even assuming that appellants' disclosure of dancer roll 34 does not constitute a disclosure of "further processing," we do not consider that appellants' disclosure would necessarily convey to those skilled in the art that appellants invented a process in which there was no further processing following drawing the yarn in a draw zone as recited in claim 11. Figs. 1 and 2 are only schematic representations of the process (specification, page 1, line 15), and there is no indication in the disclosure that the yarn should not be processed further after it is drawn. Absent such an indication, we do not consider that the application as filed can be said to contain a written description of the negative limitation, "without further processing." Cf. Ex parte Pearson, 230 USPQ 711, 712 (BPAI 1985), aff'd. mem., 795 F.2d 1017 (Fed. Cir. 1986).

Accordingly, rejection (1) will be sustained as to claims 11 to 16. However, the rejection will not be sustained as to claims 17 and 18, since these claims do not recite a "single ply" yarn or "without further processing."

Rejection (2)

In considering the § 103(a) rejections of claims 11 to 16, we must give weight to the expressions "single ply" and "without further processing," even though we have held above that they are not described in the application as filed, i.e., constitute new matter. Ex parte Pearson, supra.

With regard to claim 11, the process disclosed by Goineau employs, preferentially, a three-ply yarn (col. 2, lines 11 and 12), and the yarn is further processed following the drawing/heating step by subjecting it to an air texturing jet 22. Notwithstanding these differences between claim 11 and Goineau, the examiner asserts that the process of claim 11 is unpatentable over Goineau because (answer, pages 5 and 6):

> it would have been obvious to provide the process of Goineau (5172459) with a single ply yarn material rather than a multiply yarn material so that a single ply POY can be drawn and fully oriented as shown by Goineau(5172459). Additionally, it would have been obvious at the time the invention was made to one of ordinary skill in the art to provide the oriented yarn directly to a take up roll without further processing in order to provide a non-textured fully oriented yarn rather than a textured yarn. The use of a

> single ply instead of a multiply is merely a change in material and would bring about exactly what one of ordinary skill in the art would expect, i.e. a fully drawn and oriented single ply yarn. Additionally, the removal of the air texturing process from Goineau(5172459) brings about what one of ordinary skill in the art would expect, i.e. a non-textured, fully drawn and oriented yarn.

We do not consider this rejection to be well taken. Even assuming that it would have been obvious to apply the Goineau process to a single-ply yarn, the purpose of the process is to produce a yarn for making substrates (e.g., fabrics) which can be coated with abrasives, and the disclosure is directed toward producing a textured yarn (e.g., col. 1, line 52, to col. 2, line 2). We therefore perceive no motivation, and the examiner has suggested none, for eliminating the air texturing step from the Goineau process. The fact that one of ordinary skill would expect that removal of the air texturing step would bring about a non-textured yarn, as the examiner states, supra, does not constitute a motivation for removing that step, absent any teaching or suggestion to do so.

Rejection (2) therefore will not be sustained.

Rejection (3)

This rejection will not be sustained as to claims 12 to 14 and 16, dependent from claim 11, since Gorrafa, the secondary reference, does not overcome the deficiency in Goineau discussed above.

Claim 17 does not recite a "single ply" yarn or "without further processing." It reads:

> The process of fully orienting a 255 denier, 34 filament low molecular weight polyester yarn comprising the steps of: supplying a 255 denier, 34 filament POY yarn, heating and drawing said yarn with a draw ratio of 2.093 to produce a fully oriented yarn and taking up the fully oriented yarn.

The examiner contends that it would have been obvious to use a 210°C. temperature in the Goineau process in view of Garrafa's disclosure in Table 1, and that the other numerical values recited in claim 17 would result from routine optimization or obvious change of size (final rejection, pages 4 and 5).

Appellants do not controvert these findings by the examiner. Their only argument relative to claims 17 and 18 is that (brief, page 4):

> The addition of the reference to Gorrafa to Goineau in the rejection of Claims 12-14 and 16-18 does not help the rejection since again the drawn yarn is not directed to the take-up without further processing since Gorrafa air textures the yarn after drawing of same. The combination of Goineau and Gorrafa does not anticipate [sic: render

> obvious] the processing of a single ply low weight polyester by drawing of same in the range of 1.8-2.3 to produce a fully oriented yarn which is supplied directly to a take-up roll for use in fabric preparation in a loom or knitting machine.

However, this argument is essentially irrelevant to claims 17 and 18, since, as we have noted, they do not recite a "single ply' yarn or "without further processing."

Rejection (3) therefore will be sustained as to claims 17 and 18, but not as to claims 12 to 14 and 16.

Conclusion

The examiner's decision to reject claims 11 to 18 under § 112, first paragraph, is affirmed as to claims 11 to 16 and reversed as to claims 17 and 18. The examiner's decision to reject claims 11 to 18 under § 103(a) is reversed as to claims 11 to 16 and affirmed as to claims 17 and 18.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

IAN A. CALVERT )
Administrative Patent Judge )
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CHARLES E. FRANKFORT )
Administrative Patent Judge ) BOARD OF PATENT
) APPEALS AND
)
JOHN P. McQUADE ) INTERFERENCES
Administrative Patent Judge )

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Terry T. Moyer
P.O. Box 1927
Spartanburg, SC 29304